

REMARKS

Allowance of this application in light of the foregoing amendments and accompanying remarks is respectfully requested.

NEW INDEPENDENT CLAIM 51 AND  
DEPENDENT CLAIMS 13-14, 18, 21, 25, 30-32,  
34, 35, 39, 45, AND 48 ARE ALLOWABLE

In the Official Action dated March 12, 2004, claims 12-14, 18, 21, 25, 30-32, 34, 35, 39, 45, and 48 were rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of three (3) documents: the U.S. Patent No. 4,684,909 (to Berg et al.), U.S. Patent No. 4,919,482 (to Tyler et al.), and WO 95/20066 (to Leithem).

Of the rejected claims, claim 12 was the sole independent claim, and the remaining claims were directly or indirectly dependent on claim 12.

In this response, claim 12 has been canceled, new independent claim 51 has been added, and the remaining pending claims have each been made directly dependent on new independent claim 51.

It is respectfully submitted that the subject matter of new independent claim 51 and of the dependent claims is not obvious in view of the combination of the cited references. It is believed that when the present invention and the cited references are properly considered, it will become evident (as shown in the following discussion) that the teachings of these references do not disclose or suggest the novel composition of the present invention as claimed.

New claim 51, the only independent claim under examination at this time, sets forth,

inter alia, a material that includes a combination of air laid superabsorbent and air laid fibers, some of which are obtained from a pulp with a Kappa value less than 100 and some of which have a relatively crystallinity less than 65%, and wherein the superabsorbent and fibers have been compacted together after air laying to a density of about 0.25-0.50 g/cc and wherein the material has a suppleness of greater than about 0.7 g<sup>-1</sup>.

The Examiner has noted that the Leithem patent is silent with respect to the ratio of pulp and superabsorbent material and density. Leithem also does not teach the suppleness as claimed in a compacted air laid structure.

New independent claim 51 further sets forth, inter alia, a relative crystallinity of less than about 65%. The Berg patent, cited by the Examiner in combination with Leithem and Tyler, does not appear to teach or suggest such a relative crystallinity, and Berg, like Leithem as discussed above, also does not set forth the claimed suppleness. Further, Berg teaches, at column 7, line 4, a preferred density range of 0.12-0.25 g/cm<sup>3</sup>--different from the range of 0.25-0.50 g/cm<sup>3</sup> set forth in the instant application new independent claim 51.

The Tyler patent, which has been combined by the Examiner with the other two patents, also fails to teach, inter alia, using air laid superabsorbent and compacted fibers with the particular claimed relative crystallinity and Kappa values, density, and suppleness as claimed in independent claim 51.

An attempt to combine the various teachings of the cited patents fails, under the proper obviousness analysis, to teach or suggest the novel structure set forth in independent claim 51 in the instant application.

In the latest Official Action, the Examiner rejected clam 12 (now canceled) and alleged that the claimed suppleness is “inherent” in the “fabric” created by the combination of the three (3) references--Leithem, Berg, and Tyler.

The Examiner has the initial burden of establishing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Ex parte Levy, 17 U.S.P.Q. 2d 1461 (BPAI 1990). Here, the Examiner has not discharged that initial burden.

Further, it is improper for the Examiner to suggest that one of ordinary skill in the art might somehow modify the teachings of a prior art reference and look to a probability or possibility that a claimed structure is inherent in the prior art teachings. In In re Robertson, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999), the Court of Appeals for the Federal Circuit considered the Patent Office Board of Appeals holding that a prior art reference disclosed a specific feature, and the court noted that “the Board’s analysis rests upon the very kind of probability or possibility...that this court has pointed is insufficient to establish inherency.”

Further, as noted in Motorola v. Interdigital Technology, 43 U.S.P.Q. 2d 1481 (Fed. Cir. 1997), “[P]resumed knowledge does not grant a license to read into the prior art reference teachings that are not there.”

The art cited by the Examiner has not been shown to leave a person of ordinary skill in the art with anything more than a choice of possibilities, and there is no showing that, or reason to believe that, the cited references disclose structures which have inherent features that would be recognized by a person of ordinary skill in the art as being anticipating or

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suggestive with respect to the features set forth in the instant application new independent claim 51 relating to the claimed material that includes a combination of air laid superabsorbent and the air laid fibers, some of which are obtained from pulp with the claimed Kappa value and some of which have the claimed relative crystallinity wherein the superabsorbent and fibers have been compacted together after air laying to the claimed density and wherein the material has a suppleness of greater than about  $0.7 \text{ g}^{-1}$ .

In view of the above discussion, it is believed that new independent claim 51 is allowable. Accordingly, allowance of new independent claim 51 is respectfully requested.

--The Claims 13, 14, 18, 21, 25, 30-32, 34, 35, 39, 45, and 48 Are Allowable

The dependent claims 13, 14, 18, 21, 25, 30-32, 34, 35, 39, 45, and 48 are each dependent directly upon the above-discussed new independent claim 51. Therefore, each dependent claim includes all of the features of the independent claim 51 from which it depends.

For the reasons given above in arguing for the allowability of new independent claim 51, the dependent claims are believed to be allowable also. Therefore, withdrawal of the rejections of the dependent claims is also respectfully requested.

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It is believed that all of the claims in the application, as amended, are now in condition for allowance, and such action is earnestly solicited.

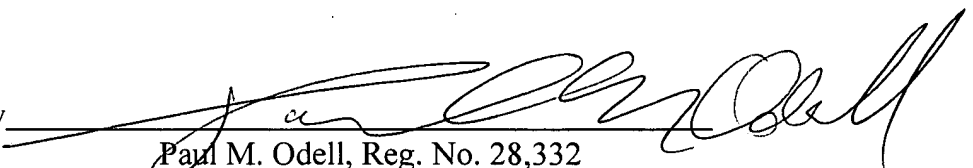
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Further, it is believed that this entire application is now in condition for allowance,  
and such action is respectfully requested.

Respectfully submitted,

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER

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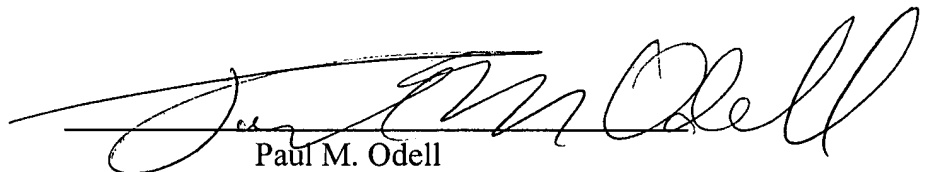


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